REMARKS

This paper is filed in response to the Office Action dated November 6, 2003. As this paper is filed on April 6, 2004 and is accompanied by a petition for a two-month extension and fee ($420), the paper is timely filed.

I. Status of Amendments

Claims 1-70 were pending prior to this amendment. By this amendment, applicant cancels claims 1-70 without prejudice to refile, and adds claims 71-101. Thus, claims 71-101 are now pending.

Because applicant previously paid fees for 3 independent and 70 total claims, an additional fee ($86) is provided based on applicant's addition of 1 independent claim.

II. Response to Office Action

A General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.[1] For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the

[1] This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

> INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '_____' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by §112").

B. The November 6 Office Action

In the November 6 Office Action, claims 24, 25, 30, 53, 54, and 59 were rejected under 35 U.S.C. §101 as being allegedly directed to non-statutory subject matter. Additionally, claims 1, 3, 5, 9, 10, 27-29, 31, 35, 39, 40, 56-58, 61, 65, 69, and 70 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by DeMar (U.S. Patent No. 6,315,660). Further, claims 2, 4, 6-8, 26, 32, 34, 36-38, 55, 60, 62, 64, and 66-68 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over DeMar in view of Falciglia (U.S. Patent No. 5,935,002), claims 11, 16, 19, 41, 46, and 49 over DeMar in view of Nicastro, Sr. (U.S. Publ. Appl. 2003/0027619), and claims 14 and 44 over DeMar in view of Nicastro, Sr. further in view of Runte et al. (U.S. Patent No. 4,015,846). In light of applicants' cancellation of claims 1-70, the rejections are moot. However, applicants have the following comments regarding claims 71-101.

Claim 71 recites a gaming apparatus including one or more display units, a wager input device, and a processor operatively coupled to at least one of the one or more display units, the wager input device, and a memory. Claim 71 further recites that the processor receives a wager via the wager input device from a player, and that the processor causes one of the one or more display units to display an image representative of a primary game. The processor determines if a bonus event trigger has occurred, and, if the bonus event trigger occurs, the processor causes one of the one or more display units to display an image representative of a bonus game playable between a representation associated with the player and a representation associated with an opponent, the representations each having at least one attribute associated with the bonus game. The processor offers the player at least one advantage option, the at least one advantage option affecting at least one of the at least one attribute of the representation associated with the player and the at least one attribute of the representation associated with the opponent. The processor also determines a payout associated with an outcome of the bonus game.

Applicants submit that claim 71 is not anticipated by DeMar or unpatentable in view of DeMar, whether taken individually or in combination with one or more of Falciglia, Nicastro, Sr. and Runte et al. It is agreed that DeMar does not disclose or teach "competition between players." November 6 Office Action, page 5, lines 12-13. To the extent that it is suggested in the Office Action that other references "teach competition between players," it is stated several times that an advantage option affecting the player or the opponent is not

disclosed, taught or suggested by the cited references. November 6 Office Action, page 7, lines 18-19 ("changing the size of player or opponent paddles" not taught or suggested); page 8, line 8 ("changing the size of player or opponent stick" not taught or suggested); and page 8, line 11 ("changing the size of player or opponent goal" not taught or suggested). Claim 71 recites an advantage option affecting the player or the opponent, in that the claim recites at least one advantage option, the at least one advantage option affecting at least one of the at least one attribute of the representation associated with the player and the at least one attribute of the representation associated with the opponent. Therefore, claim 71, in keeping with the examiner's comments made in the November 6 Office Action, is neither anticipated by nor rendered unpatentable by DeMar, Falciglia, Nicastro, Sr. and Runte et al., and claim 71 and claims 72-84 that depend from claim 71 are allowable.

Claim 85 recites a gaming apparatus including one or more display units, a wager input device, and a processor operatively coupled to at least one of the one or more display units, the wager input device, and a memory. Claim 85 further recites that the processor receives a wager via the wager input device from a player, and the processor causes one of the one or more display units to display an image representative of a primary game. The processor determines if a bonus trigger event has occurred, and, if the bonus event trigger occurs, the processor causes one of the one or more display units to display an image representative of a ping-pong game playable between a paddle associated with the player and a paddle associated with an opponent. The processor offers the player at least one advantage option, the at least one advantage option affecting at least one of the paddle associated with the player and the paddle associated with the opponent. The processor determines a payout associated with an outcome of the ping-pong game.

Applicants submit that claim 85, similar to previously presented claim 12, recites that the processor offers the player at least one advantage option, the at least one advantage option affecting at least one of the paddle of the player and the paddle of the opponent. As claim 12 was found to be allowable in the November 6 Office Action (page 7, paragraph 8), applicant submits that claim 85 should also be allowable. Moreover, to the extent that claim 85 is allowable, claim 86 that depends from claim 85 is also allowable.

As to claim 87, the claim recites receiving a wager from a player, displaying an image representative of a primary game, and determining if a bonus event trigger has occurred. Claim 87 further recites displaying an image representative of a bonus game, the bonus game

including a representation associated with the player and a representation associated with an opponent, the representations each having at least one attribute associated with the bonus game, if the bonus event trigger occurs. Claim 87 further recites offering the player at least one advantage option, the at least one advantage option affecting at least one of the at least one attribute of the representation associated with the player and the at least one attribute of the representation associated with the opponent, and determining a payout associated with an outcome of the bonus game.

Claim 87, similar to claim 71, recites that the player is offered at least one advantage option, the at least one advantage option affecting at least one of the at least one attribute of the representation associated with the player and the at least one attribute of the representation associated with the opponent. Therefore, the applicants submit that the arguments made with respect to claim 71 apply with equal force to claim 87. Moreover, to the extent that claim 87 is allowable, claims 88-99 that depend from claim 87 are also allowable.

Claim 100 recites receiving a wager from a player, displaying an image representative of a primary game, and determining if a bonus event trigger has occurred. Claim 100 further recites displaying an image representative of a ping-pong game, the ping-pong game including a paddle associated with the player and a paddle associated with an opponent, if the bonus event trigger occurs. The method also includes offering the player at least one advantage option, the at least one advantage option affecting at least one of the paddle associated with the player and the paddle associated with the opponent, and determining a payout associated with an outcome of the ping-pong game.

Claim 100, similar to claim 85, recites that the player is offered at least one advantage option, the at least one advantage option affecting at least one of the paddle associated with the player and the paddle associated with the opponent. Therefore, the applicants submit that the arguments made with respect to claim 85 apply with equal force to claim 100. Moreover, to the extent that claim 100 is allowable, claim 101 that depends from claim 100 is also allowable.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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